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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,934	09/28/2000	John Hadfield	00AB183	7590

7590 09/13/2007
John J Horn
Allen-Bradley Company LLC
Patent Dept 704P Floor 8 T-29
1201 South Second Street
Milwaukee, WI 53204-2496

EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/672,934

Applicant(s)

HADFIELD ET AL.

Examiner

Matthew S. Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 20, 22-25, 31-35 and 37-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20, 22-25, 31-35 and 37-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1-11, 20, 22-25, 31-35 and 37-54 are pending in the present application and rejected as set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 20, 22-25, 31-35 and 37-54 are rejected under 35 U.S.C. 112, second paragraph.

All of the independent claims recite the limitation of configuring or programming the memory objects "after assembly." There is insufficient antecedent basis for this limitation in the claim. It is unclear if "after assembly" refers back to "assembling the system" or to the assembly of the actual individual memory object.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 20, 22-25, 31-35 and 37-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skoolicas (U.S. Patent No. 6,230,403).

Referring to claim 1. Skoolicas discloses a method for selling engineered electrical systems (column 2, lines 26-51), the method comprising the steps of:

generating a database for an electrical system comprising a plurality of programmable devices, the database including device designation data (column 32, lines 36-62);

soliciting an order for the system (column 31, lines 48-59);

assembling the system including the plurality of programmable devices in accordance with the order (column 32, lines 36-62); and

configuring memory objects within the devices by downloading at least the device designation data from the database (column 2, lines 42-51 and column 34, lines 41-57) into respective memory objects of the devices (column 34, lines 26-35 and column 35, lines 17-20: Please see Opinion decided before The Board of Patent Appeals and Interferences decided March 30, 2007, page 3-4).

The Examiner notes, the specification as originally filed (9/28/2000) discloses designation data as code, which identifies or designates the system, the components, and physical location or configuration information for the components (Specification as originally filed: page 12, lines 26-28).

The Examiner further notes, Skoolicas discloses that the programmable devices are programmed using programming specifications provided by the SMI (Skoolicas: column 34, lines 41-57).

Skoolicas further discloses that the specifications for a power supply are application specific. Thus, while many power supplies may share certain common characteristics such as a similar input voltage range or the presence of a 5-volt output, many power supplies are customized, by design, for use in a particular product or system (Skoolicas: column 1, lines 6-18). Furthermore, as taught by Skoolicas (Skoolicas: column 4, lines 12-19), the power supply specifications may include at least one of the following details: (a) a shape of the user-defined package, (b) a dimension of the user-defined package, (c) a position of at least one of the components in the user-defined package, (d) an orientation of at least one of the components in the user-defined package. Therefore, the power supply specification data that is programmed into the programmable device as discussed in Skoolicas sufficiently anticipates the meaning of "Designation Data" as defined by the applicant.

However, even though Skoolicas discloses all the claimed elements as indicated above, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The

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particular data stored does not patentable distinguish the claimed method and is given little patentable weight.

Skoolicas does not expressly disclose configuring memory objects within the devices by downloading, after assembly of the system, at least the device designation data from the database into respective memory objects of the devices.

However the particular order of the configuration step would have been obvious because of the absence of any new or unexpected results. Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

It would have been obvious to one of ordinary skill in the art to configure the memory objects at any time within the execution of the process steps because the applicant has not persuasive demonstrated the criticality of only providing the configuring step after assembly of the system.

Referring to claim 2. Skoolicas further discloses a method comprising the step of designing the electrical system including the plurality of programmable devices (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 3. Skoolicas further discloses a method wherein the device designation data includes data representative of a physical location of a device in the system (column 32, lines 36-62).

The Examiner notes, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The particular data stored does not patentably distinguish the claimed method and is given little patentable weight.

Referring to claim 4. Skoolicas further discloses a method wherein the device designation data includes data representative of a function of a device in the system (column 32, lines 36-62).

The Examiner notes, the data included within the designation data qualifies as descriptive material since it is directed to the content of data, not structure or an action or step. The particular data stored does not patentably distinguish the claimed method and is given little patentable weight.

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Referring to claim 5. Skoolicas further discloses a method wherein the step of soliciting the order includes computing price data, based upon the database (column 31, lines 48-59).

Referring to claim 6. Skoolicas further discloses a method comprising the step of storing the database in a computer coupled to the system (Figure 5).

Referring to claim 7. Skoolicas further discloses a method wherein the system includes a plurality of subassemblies, at least a portion of the subassemblies including at least one programmable device, and wherein the memory objects of the programmable devices are configured after arrangement of the devices on the subassemblies (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 8. Skoolicas further discloses a method wherein the memory objects of the programmable devices are configured prior to arrangement of the subassemblies in the system (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 9. Skoolicas further discloses a method wherein the memory objects of the programmable devices are configured after arrangement of the subassemblies in the system (column 2, lines 42-51 and column 34, lines 41-57).

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Referring to claim 10. Skoolicas further discloses a method wherein the devices include electrical power switching devices mounted within an enclosure (column 1, line 4 to column 2, line 24).

Referring to claim 11. Skoolicas further discloses a method wherein the system includes a motor control center (column 1, line 4 to column 2, line 24).

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 23. Skoolicas further discloses a method wherein the step of programming the programmable components is performed following final assembly of the components in the system (column 2, lines 42-51 and column 34, lines 41-57).

Referring to claim 24. Skoolicas further discloses a method wherein the step of assembling the system includes coupling the components to a data network in the system for accessing data from each programmable component (column 20, lines 1-14).

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Referring to claim 25. Skoolicas further discloses a method wherein the programmable components are programmed via the data network (Figure 5).

Referring to claim 31. Claim 31 is rejected under the same rational as set forth above in claim 1.

Referring to claim 32. Claim 32 is rejected under the same rational as set forth above in claim 4.

Referring to claim 33. Claim 33 is rejected under the same rational as set forth above in claim 3.

Referring to claim 34. Claim 34 is rejected under the same rational as set forth above in claim 1.

Referring to claim 35. Claim 35 is rejected under the same rational as set forth above in claim 4.

Referring to claim 37. Claim 37 is rejected under the same rational as set forth above in claim 6.

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Referring to claim 38. Claim 38 is rejected under the same rational as set forth above in claim 7.

Referring to claim 39. Claim 39 is rejected under the same rational as set forth above in claim 8.

Referring to claim 40. Claim 40 is rejected under the same rational as set forth above in claim 9.

Referring to claim 41. Claim 41 is rejected under the same rational as set forth above in claim 7.

Referring to claim 42. Claim 42 is rejected under the same rational as set forth above in claim 1.

Referring to claim 43. Claim 43 is rejected under the same rational as set forth above in claim 3.

Referring to claim 44. Claim 44 is rejected under the same rational as set forth above in claim 9.

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Referring to claim 45. Claim 45 is rejected under the same rational as set forth above in claim 24.

Referring to claim 46. Claim 46 is rejected under the same rational as set forth above in claim 25.

Referring to claims 47-54. Claims 47-54 are rejected under the same rationale as set forth above in claims 1-11, 20, 22-25, 31-35 and 37-46.

Response to Arguments

Applicant's arguments filed 7/30/2007 have been fully considered but they are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSG
Primary Examiner
AU 3625


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600